

**Notice of Allowability**

Application No.

09/750,154

Examiner

Jonathan Ouellette

Applicant(s)

FRANK ET AL.

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 2/16/2007.
2. ☒ The allowed claim(s) is/are 2-4, ~~10-16~~ and 35-54.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Notice of Informal Patent Application  |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date <u>20061127</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date <u>20070207, 20060828</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment   |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                             | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance                         |
|  | 9. <input type="checkbox"/> Other _____.   |

## DETAILED ACTION

### *Response to Amendment*

1. Claims 1, 5-9, 17-34 have been cancelled; therefore Claims 2-4, 10-16, and 35-54 are currently pending in application 09/750,154.

### *Claim Rejections - 35 USC § 112*

2. The rejection of Claims 11, 35, 41, and 48 under 35 U.S.C. 112, first paragraph, is withdrawn due to Applicant's amendments and arguments.

### *Claim Rejections - 35 USC § 103*

3. The rejection of Claims 2-4, 11-13, and 35-50 under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 6,298,327 B1), is withdrawn due to Applicant's amendments.

### *Allowable Subject Matter*

4. Claims 2-4, 10-16, and 35-54 are allowed.
5. The following is an examiner's statement of reasons for allowance:
6. As per **independent Claims 11 and 48**, the prior art does not teach or suggest a method (computer-readable medium, programmed apparatus) for completing a marketing opportunity assessment on only the *intellectual property rights* (not an actual product or service), as claimed by the independent claims.

7. **Hunter et al. (US 6,298,327)** Hunter discloses a method (computer readable medium) for determining whether to obtain licensing rights for an intellectual property asset, the method comprising: receiving intellectual property asset protection data, wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets (inventive disclosure), wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception); storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records (Fig.2), wherein each intellectual property asset protection data records of the plurality of intellectual property asset protection data records in the intellectual property asset protection database corresponds to at least one intellectual property asset; providing intellectual property asset protection data from at least one intellectual property asset protection data record in the intellectual property marketing opportunity system (C4 L21-32, C8 L11-18, Marketability analysis).
8. Hunter fails to expressly disclose completing a marketing opportunity assessment on only the *intellectual property rights* (not an actual product or service), as claimed by the independent claims.
9. As per **independent Claims 35 and 41**, the prior art does not teach or suggest a method (computer-readable medium, programmed apparatus) for use with a computer for managing marketing of a plurality of *intellectual property rights assets*, the method

comprising, determining a market value for intellectual property rights assets; and generating a marketing project plan with a schedule of marketing tasks for the at least one intellectual property rights asset, based on both a template plan and on the determined market value (analyzing and developing a marketing plan for IP rights – not IP innovations or products).

10. **Hunter et al. (US 6,298,327)** Hunter discloses a computer-readable medium containing a program for use in a computer (method) for determining whether to obtain licensing rights for an intellectual property asset, the program comprising the steps of: receiving intellectual property asset protection data, wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets (inventive disclosure), wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception); storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records (Fig.2), wherein each intellectual property asset protection data records of the plurality of intellectual property asset protection data records in the intellectual property asset protection database corresponds to at least one intellectual property asset; providing intellectual property asset protection data from at least one intellectual property asset protection data record in the intellectual property marketing opportunity system; wherein the determining includes generating an assessment of the marketability for at least one

intellectual property asset corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database (C4 L21-32, C8 L11-18, Marketability analysis).

11. Hunter fails to expressly disclose completing a marketing opportunity assessment on only the *intellectual property rights* (not an actual product or service), as claimed by the independent claims.
12. The remaining dependent **Claims 2-4, 10, 12-16, 36-40, 42-47, and 49-54** are considered allowable, as they are dependent and based off of an allowable independent claim.
13. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


#### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

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16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

April 21, 2007

  
JONATHAN OUELLETTE  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600